



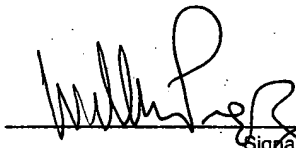
AF/8  
JW

Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

Approved for use through xx/xx/200x. OMB 0651-00xx  
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) P21017	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]  on _____  Signature _____  Typed or printed name _____	Application Number 09/931,881		Filed August 20, 2001
	First Named Inventor M. NAKASHIMA		
	Art Unit 2613	Examiner Shawn S. An	
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p>			
I am the		 William Pieprz Reg. No. 33,630	
<input type="checkbox"/> applicant/inventor.		Signature	
<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)		Bruce H. Bernstein	
<input checked="" type="checkbox"/> attorney or agent of record. 29,027 Registration number _____		Typed or printed name (703) 716-1191	
<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____		Telephone number July 28, 2005	
		Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.			
<input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted.			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



GREENBLUM & BERNSTEIN, P.L.C.  
Intellectual Property Causes  
1950 Roland Clarke Place  
Reston, VA 20191  
(703) 716-1191

Attorney Docket No. P21017

**Mail Stop Amendment**

In re application of : Masaaki NAKASHIMA

Application No : 09/931,881

Group Art Unit: 2613

Filed : August 20, 2001

Examiner : Shawn S. An

For : IMAGING ELEMENT FOR ELECTRONIC ENDOSCOPES AND ELECTRONIC ENDOSCOPE  
EQUIPPED WITH THE IMAGING ELEMENT

**Mail Stop Amendment**

Commissioner for Patents  
U.S. Patent and Trademark Office  
Customer Service Window, Mail Stop Amendment  
Randolph Building  
401 Dulany Street  
Alexandria, VA 22314

Sir:

Transmitted herewith is a **Pre-Appeal Brief Request for Review** in the above-captioned application.

☐ Small Entity Status of this application under 37 C.F.R. 1.9 and 1.27 has been established by a previously filed statement.

☐ A verified statement to establish small entity status under 37 C.F.R. 1.9 and 1.27 is enclosed.

☐ An Information Disclosure Statement, PTO Form 1449, and references cited.

☒ A Request for Extension of Time.

☐ No additional fee is required.

☒ Notice of Appeal.

The fee has been calculated as shown below:

Claims After Amendment	No. Claims Previously Paid For	Present Extra	Small Entity		Other Than A Small Entity	
			Rate	Fee	Rate	Fee
Total Claims: 17	*20	0	X25=	\$	x 50=	\$0.00
Indep. Claims: 2	**3	0	X100=	\$	X200=	\$0.00
Multiple Dependent Claims Presented			+180=	\$	+360=	\$0.00
Notice of Appeal fee				\$		\$500.00
Extension Fees for two Month(s)						\$330.00
Total:				\$	Total:	\$830.00

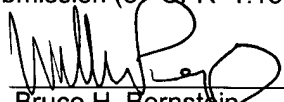
☐ Please charge my Deposit Account No. 19-0089 in the amount of \$\_\_\_\_\_.


☒ A Check in the amount of **\$830.00** to cover the filing/extension fee(s) is included.

☒ The U.S. Patent and Trademark Office is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. 19-0089.

☒ Any additional filing fees required under 37 C.F.R. 1.16.

☒ Any patent application processing fees under 37 C.F.R. 1.17, including any required extension of time fees in any concurrent or future reply requiring a petition for extension of time for its timely submission (37 CFR 1.136)(a)(3).

  
Bruce H. Bernstein  
Reg. No. 29,027

  
William Pieprz  
Reg. No. 33,630

P21017.A07



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Masaaki NAKASHIMA                      Group Art Unit: 2613  
Appln. No. : 09/931,881                                  Examiner: Shawn S. An  
Filed : August 20, 2001                                  Confirmation No.: 4044  
For : IMAGING ELEMENT FOR ELECTRONIC ENDOSCOPES AND  
ELECTRONIC ENDOSCOPE EQUIPPED WITH THE IMAGING  
ELEMENT

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Commissioner for Patents  
U.S. Patent and Trademark Office  
Customer Service Window  
ATTN: Mail Stop AF  
Randolph Building  
401 Dulany Street  
Alexandria, VA 22314

Sir:

In response to the Final Official Action of February 28, 2005, and concurrently with the filing of a Notice of Appeal, Applicant respectfully requests a pre-appeal brief panel to review and withdraw the outstanding rejections set forth in the above-mentioned Official Action in view of the herein contained remarks.

**Remarks** begin on page 2 of this paper.

**REMARKS**

In the Final Official Action, the Examiner rejected independent claims 1 and 9 under 35 U.S.C. § 102(e) as being anticipated by NAKAMURA (U.S. Patent 6,476,851). Further, other claims stand rejected on various grounds with NAKAMURA as the primary reference.

**The following comments refer to recitations provided in at least claims 1 and 9:**

**A. NAKAMURA fails to disclose "...an image sensor mounted on the base...".**

The Examiner argues that the claimed base is met by element 85 (see Advisory Action and Final Official Action).

Applicant submits that NAKAMURA discloses element 85 to be a CCD glass cover (column 15, line 9) and not a base with an image sensor mounted thereon. Further, NAKAMURA does not disclose an image sensor as being mounted on the glass cover.

**B. NAKAMURA fails to disclose "...a predetermined circuit mounted on the base for receiving a signal from the image sensor...".**

The Examiner relies upon "visual inherency" (Advisory Action) and argues that the predetermined circuit is the intricate circuitry of the conventional endoscope utilizing CCD because a conventional endoscope's inherent function is to capture and take out an image signal from the image sensor.

As noted above, the Examiner relies upon the glass cover 85 of NAKAMURA as being the claimed base. However, Applicant submits that there is no circuit mounted on the glass cover 85, as evidenced by at least Figure 18, which depicts a second lens unit 83

P21017.A07

as being cemented on the glass cover 85. That is, NAKAMURA does not disclose a circuit that is positioned in the manner recited in the claims.

Furthermore, the Examiner's interpretation of the predetermined circuit being the CCD itself is incorrect. The claim recites that the circuit receives a signal "from" the image sensor. Thus, the image sensor and the circuit are distinct elements.

Moreover, with regards to "visual inherency", the Examiner has not presented any evidence that Applicant's claimed features are "necessarily" present in NAKAMURA. Although Applicant does not dispute the existence of circuits in endoscopes, Applicant submits that such circuits could be positioned anywhere (e.g., remotely from the image sensor and base) and not necessarily in the claimed arrangement. Further, the Examiner must provide a basis in fact and/or technical reasoning, which reasonably supports the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. However, the Examiner has failed to provide this required basis for relying on "inherency".

**C. NAKAMURA fails to disclose an image sensor and a predetermined circuit mounted on a base.**

Applicant submits that there is no disclosure of circuits mounted on the glass cover 85 of NAKAMURA. Further, NAKAMURA does not disclose any predetermined circuits as being distinct and separate from the CCD (i.e., the image sensor) and which are mounted on the glass cover 85.

P21017.A07

**D. NAKAMURA fails to disclose "...the predetermined circuit is arranged along the periphery of the light receiving surface of the image sensor [on the base] so that a center of the base on the light receiving surface of the image sensor is substantially aligned with a center of the effective imaging region of the image sensor".**

In NAKAMURA, there are no circuits disclosed to be on the glass cover 85 (which the Examiner has interpreted to be the claimed base). Further, NAKAMURA is silent with respect to providing an "effective imaging region". Accordingly, NAKAMURA cannot meet the above-noted claim recitations.

#### **SUMMARY**

Applicant believes that the present application is in condition for allowance, and respectfully requests an indication to that effect. Applicants have argued the allowability of the claims and pointed out the shortcomings of the applied references. Accordingly, withdrawal of the outstanding rejections and passage of the present application to issue is respectfully requested.

Respectfully submitted,  
Masaaki NAKASHIMA



William Pieprz  
Reg. No. 33,630

Bruce H. Bernstein  
Reg. No. 29,027

July 28, 2005  
GREENBLUM & BERNSTEIN, P.L.C.  
1941 Roland Clarke Place  
Reston, VA 20191  
(703) 716-1191